REMARKS

Status of the Claims.

Claims 26-28 and 48-51 are pending with entry of this amendment, no claims being cancelled and no claims being added herein. Claims 26, 51, are amended herein. These amendments introduce no new matter. Support is replete throughout the specification.

Claim Objections.

Claim 51 was objected to under 37 C.F.R. §1.75(c) as allegedly being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 51 is amended herein to recite "consisting of" instead of "comprising" thereby obviating this objection.

Claim 26 was objected to because of the typographical error of "probeconsiting". Claim 26 is amended herein to correct this typographical error thereby obviating this rejection.

35 U.S.C. §112, Second Paragraph.

Claims 26-28 were rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite because allegedly the language "the target polynucleotide sequence" in claim 26 is unclear. Per the Examiner's recommendation, claim 26 is amended to substitute --nucleic acid sample-- for "target polynucleotide" thereby obviating this rejection.

35 U.S.C. §102.

Claims 26-28, and 48-51 were rejected under 35 U.S.C. §102(a) as allegedly anticipated by Tanner *et al.* (1995) *Clin. Cancer Res.*, 1: 1455-1461 or Tanner *et al.* (1996) *Cancer Res.*, 56: 3441-3445. In particular, the Examiner alleged that the specification teaches that SEQ ID NO:9 is contained within the region of chromosome 20 spanned by the RMC20C001 probe. The Examiner then further alleged that cosmid probe RMC20C001 would hybridize to a target sequence consisting essentially of SEQ ID NO:9 and SEQ ID NO:10 because RMC20C001 encompasses SEQ ID NO:10. Applicants traverse.

Contrary to the Examiner's assertion, RMC20C001 **does not encompass SEQ ID NO:10 or SEQ ID NO:9. SEQ ID NOS:9 and 10 are the ZABC1 genomic DNA and cDNA, respectively.** The specification, at page 19, lines 10-13 states:

> The minimum common region of amplification (MCA) was mapped to a ~600 kb interval flanked by P1 clones #3 and #12 with the highest level of

amplification detected by **P1 clone #38 corresponding to RMC20C001** (Figures 3 and 7). [emphasis added]

Inspection of Figure 3 shows that RMC20C001 (P1 clone 38) is localized near locus D20S183. In contrast, inspection of Figure 7 shows that ZABC1 is localized near locus D20S211. It can be seen in Figure 3 that D20S211 is quite some distance from D20S183 and there is clearly no overlap between RMC20C001 and ZABC1.

In view of the fact that the cited art teaches no probe other than RMC20C001 and there is no overlap whatsoever between RMC20C001 and the probes recited in the presently pending claims, the Examiner has failed to show that this element of the pending claims is to be found in the recited art. Accordingly, the Examiner has failed to make her *prima facie* case under 35 U.S.C. §102(a) and the rejection of claims 26-28, and 48-51 on these grounds should be withdrawn.

In view of the foregoing, Applicants believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Should the Examiner seek to maintain the rejections, Applicants request a telephone interview with the Examiner and the Examiner's supervisor.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 769-3513.

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Respectfully submitted,

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